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Docket No.: 03191/000J838-USO  
(PATENT)

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Patent Application of:  
Wolfgang Reik et al.

Application No.: 09/982,136

Confirmation No.: 7044

Filed: October 12, 2001

Art Unit: 3682

For: MOTOR VEHICLE

Examiner: J. K. Smith

**APPELLANTS' BRIEF**

MS Appeal Brief - Patents  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Dear Sir:

This brief is in furtherance of the Notice of Appeal, filed in this case on April 9, 2004.

The fees required under § 1.17(f) and any required petition for extension of time for filing this brief and fees therefor, are dealt with in the accompanying TRANSMITTAL OF APPEAL BRIEF.

This brief is transmitted in triplicate.

This brief contains items under the following headings as required by 37 C.F.R. § 1.192 and M.P.E.P. § 1206:

- I. Real Party In Interest
- II Related Appeals and Interferences
- III. Status of Claims
- IV. Status of Amendments

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- V. Summary of Invention
- VI. Issues
- VII. Grouping of Claims
- VIII. Arguments
- IX. Claims Involved in the Appeal
- Appendix A Claims

I. REAL PARTY IN INTEREST

The real party in interest for this appeal is:

LuK Lamellen und Kupplungsbau Beteiligungs KG

II. RELATED APPEALS AND INTERFERENCES

There are no other appeals or interferences which will directly affect or be directly affected by or have a bearing on the Board's decision in this appeal.

III. STATUS OF CLAIMS

A. Total Number of Claims in Application

There are 15 claims pending in application.

B. Current Status of Claims

1. Claim 6 has been canceled.
2. Claims 1-5 and 7-16 are pending in the present application.
3. Claims 1-5 and 7-16 stand finally rejected as set forth in the Office Action dated January 13, 2004.

C. Claims On Appeal

The claims on appeal are claims 1-5 and 7-16.



assembly concept, the assembly unit 300 can be functionally tested before it is installed in the final assembly.

## VI. ISSUES

The first issue is whether claims 1-5,7-8 and 6-12 should be rejected under 35 U.S.C. 103(a) as being unpatentable over Hardeman et al. (U.S. Patent 5,267,488) in view of Machida et al. (U.S. Patent 4,719,812).

The second issue is whether claims 9-11 should be rejected under 35 U.S.C. 103(a) as being unpatentable over Hardeman ('488) in view of Machida et al.('812) as applied to claims 1-5,7-8 and 6-12 above, and further in view of Burkett (U.S. Patent 5,566,591).

## VII. GROUPING OF CLAIMS

Independent claim 1 is believed to be independently patentable over the cited art for the reasons set forth below. Dependent claims 2-5, and 7-16 stand or fall together with independent claim 1.

## VIII. ARGUMENTS

### **(i) 35 U.S.C. 101**

There is no rejection based upon 35 U.S.C. 101.

### **(ii) 35 U.S.C. 112**

There is no rejection based upon 35 U.S.C. 112.

### **(iii) 35 U.S.C. 102**

There is no rejection based upon 35 U.S.C. 102.

**(iv) 35 U.S.C. 103**

(Issue No. 1) Claims 1-5, 7-8, and 6-12 stand rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. patent No. 5,267,488 to Hardeman et al. in view of U.S. patent No. 4,719,812 to Machida et al.

The rejection of claims 1-5 in particular is based on the Examiner's reading of claims 1-5 on a combination of selected features of Hardeman's "Drive Train Conversion Apparatus" and Machida's "Transmission Casing Including a Hydraulic Clutch".

Appellants respectfully disagree with the Examiner's findings regarding Hardeman et al. at least where the Examiner writes that:

*"Hardeman discloses a motor vehicle (V) comprising .....a clutch actuator device, the clutch actuator device including a clutch release device (36) with a clutch release drive source (62)."*

*"Hardeman et al. further discloses ....., a control device...."*

*"The control device is operable to control the clutch in an automated mode",*

*"The clutch release drive source and the clutch release device are both integrated in the carrier element (see col. 5, lines 5-8)".*

In response to the foregoing statements by the Examiner, Appellants note that according to Hardeman et al., col. 4, line 68, to col. 5, line 4, the release bearing 36 is operating conventionally by apparatus including a lever (not shown) projecting from an operating shaft 62 housed in a bore 64 located in the adapter housing 10. The term "conventionally" in the context of an "early Volkswagen" (see col. 4, line 35), can only mean that the clutch is a "manually" operated clutch, as is also stated in col. 3, line 10 of

the Hardeman reference. This view is further supported by the fact that Hardeman lacks a control device that is operable to control the clutch in an automated mode, as required by claim 1 of the present application. Thus, contrary to the Examiner's findings:

- Hardeman has no clutch release drive source other than the driver's foot.
- Hardeman has no control device operable to control the clutch in an automated mode.
- Hardeman's "clutch operating means" which the Examiner found to be "provided integrally with the adapter housing 10" (col. 5, lines 5-8) obviously cannot include a drive source as required in claim 2 of the present application.

Appellants also respectfully disagree with the Examiner's finding that *"Machida et al. teaches an automatic clutch actuator device (3) comprising hydraulic conduits and hydraulic elements such as a valve and cylinder (11, 12, 13, 17)."*

Based on a careful analysis of the Machida et al. reference, Appellants found that Machida's elements 11, 12, 13 are hydraulic cylinders arranged on the outside of the transmission housing to operate the change speed mechanisms A and B (col. 2, lines 34-37) and that element 17 is a hydraulic valve for the manual operation of the forward/backward switching device C (col. 2, lines 54-57). A hydraulically operated multi-disk clutch 3 is referred to in col. 2, lines 16-17. A flow passage 38a for supplying oil to the clutch 3 is referred to in col. 4, lines 9-11. The flow passage 38a appears to lead into a concentric clutch release cylinder inside the clutch itself. Thus, Machida's clutch actuator

device in the form of the concentric clutch release cylinder and piston is integrated in the clutch itself. Consequently, Machida et al. does not conform to claim 1 of the present application which requires that *"at least portions of at least one of the clutch-actuator device and the control device are integrated in the carrier element; and said carrier element is arranged in an intermediate area between the clutch bell housing and the transmission housing"*. Machida's multi-disk clutch with an actuator piston integrated in the clutch requires a more space-consuming design of the clutch and is thus a prime example for exactly the kind of problem that the present invention aims to solve. (See page 2 of the specification: *"Thus, a large number of components need to be arranged in the clutch bell housing, which leads to problems due to space limitations."*) .

A skilled-in-the-art person contemplating a combination of Hardeman et al. with Machida et al. would find no suggestion leading towards the solution proposed by the present invention. Hardeman alone already immensely increases the axial length of the power train. Machida at least requires more axial space than the solution proposed in the present invention. Thus, a skilled-in-the-art person looking for a solution to solve the *"problems due to space limitations"* as described in the present application would have no reason to combine Hardeman et al. with Machida et al. in order to solve those problems.

As a conclusion of the foregoing argument, Appellants respectfully assert that Hardeman et al. and Machida et al., whether considered individually or in any combination, would have been rejected by any skilled-in-the-art person as unsuitable to provide a solution in accordance with claim 1 of the present application and therefore fail to meet the criteria for making claim 1 of the present application unpatentable under 35 U.S.C. 103(a).





## IX. CLAIMS INVOLVED IN THE APPEAL.

A copy of the claims involved in the present appeal is attached hereto as Appendix A. As indicated above, the claims in Appendix A do include the amendments filed by Applicant on April 11, 2003, and do not include the amendment(s) filed on February 27, 2004.

## Conclusion

For the foregoing reasons, the final rejection of claims 1-5 and 7-16 should be reconsidered by the Examiner or reversed in its entirety by the Board. Claims 1-5 and 7-16 are patentable over the prior art of record. Accordingly, the Examiner's finding of unpatentability should be reversed. Such a disposition is earnestly solicited.

Dated: July 8, 2004

Respectfully submitted,

By

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**TRANSMITTAL OF APPEAL BRIEF**Docket No.  
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In re Application of: Wolfgang Reik et al.

Application No.  
09/982,136-Conf. #7044Filing Date  
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J. K. SmithGroup Art Unit  
3682

Invention: MOTOR VEHICLE

**TO THE COMMISSIONER OF PATENTS:**Transmitted herewith in triplicate is the Appeal Brief in this application, with respect to the Notice of Appeal filed: April 9, 2004.The fee for filing this Appeal Brief is 330.00.☒ Large Entity ☐ Small Entity☒ A check in the amount of 330.00 is enclosed.☐ Charge the amount of the fee to Deposit Account No. \_\_\_\_\_  
This sheet is submitted in duplicate.☐ Payment by credit card. Form PTO-2038 is attached.☒ The Director is hereby authorized to charge any additional fees that may be required or credit any overpayment to Deposit Account No. 04-0100.  
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